



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,521	02/26/2004	Kent F. Hayes JR.	RSW920030231US1	6458
45541 7590 06/24/2009 HOFFMAN WARNICK LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207				
EXAMINER NAHAR, QAMRUN				
ART UNIT 2191		PAPER NUMBER		
NOTIFICATION DATE 06/24/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

10/787,521

Applicant(s)

HAYES, KENT F.

Examiner

QAMRUN NAHAR

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date 02/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the amendment filed on 02/25/2009.
2. Claim 32 has been amended.
3. Claims 1-36 are pending.

Response to Amendment

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 8, 13, 23 and 27 have been amended to recite “the native environment being an environment of a primary operating system of the client device”, which is new matter. The specification provides no support for this limitation.

Applicant merely pointed out that “the OSGi bundle 16 will be deployed in native environment” and not “the native environment being *an environment of a primary operating system* of the client device” (emphasis added). Therefore, there is no support for this limitation, thus, this is new matter.

Claims 2-7, 9-12, 14-22, 24-26 and 28-36 are rejected for dependency upon rejected base claims 1, 8, 13, 23 and 27 above, respectively.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1, 8, 13, 23 and 27 have been amended to recite “the native environment being an environment of a primary operating system of the client device”, which renders the claim indefinite. The specification provides no support for this limitation.

Applicant merely pointed out that “the OSGi bundle 16 will be deployed in native environment” and not “the native environment being *an environment of a primary operating system* of the client device” (emphasis added). Therefore, there is no support for this limitation, thus, this is new matter, rendering the claims indefinite.

Claims 2-7, 9-12, 14-22, 24-26 and 28-36 are rejected for dependency upon rejected base claims 1, 8, 13, 23 and 27 above, respectively.

9. As previously pointed out in the previous Office Action (Mailed on 5/17/2007, par. 12), claims 1, 4-11, 13, 15, 17, 20, 23, 25, 27, 29, 31 and 34 contain the trademark/trade name OSGI. Where a trademark or trade name is used in a claim as a limitation to identify or describe a

particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe bundles and, accordingly, the identification/description is indefinite. See MPEP 2173.05(u).

Claims 2-7, 9-12, 14-22, 24-26 and 28-36 are rejected for dependency upon rejected base claims 1, 8, 13, 23 and 27, respectively, above.

10. As previously pointed out in the previous Office Action (Mailed on 5/17/2007, par. 13), claims 5 and 11 contain the trademark/trade name WIN32. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather

than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe application programming interface in Windows 95 and Windows NT and, accordingly, the identification/description is indefinite. See MPEP 2173.05(u).

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
13. Claims 1-7 are directed to a method. However, the recited steps of the method are held to be non-statutory subject matter because the recited steps of the method are (1) not tied to another statutory class (such as a particular apparatus) or (2) not transforming the underlying subject matter (such as an article or materials) to a different state or thing. Applicant is advised to amend the claims to recite "[a] computer-implemented method" in order to overcome the § 101 rejections.

14. Claims 8-12 are directed to a method. However, the recited steps of the method are held to be non-statutory subject matter because the recited steps of the method are (1) not tied to another statutory class (such as a particular apparatus) or (2) not transforming the underlying subject matter (such as an article or materials) to a different state or thing. Applicant is advised to amend the claims to recite "[a] computer-implemented method" in order to overcome the § 101 rejections.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Bansal (US 2003/0191823).

Per Claim 1:

The Bansal publication discloses:

- **packaging a native application within an OSGi bundle to create a link between the OSGi bundle and the native application** ("... The Active Framework system and method of the present inventions hosts services that are packaged as bundles, which are containers ... that

includes executable as well as non-executables resources for a service. An exemplary bundle comprises Java class files, native library files ..." in par. 0041, lines 1-17; and "... there is illustrated an exemplary embodiment of a bundle packaging. A bundle may contain many types of files. If the service packaged inside the bundle was originally developed in a programming language, e.g., C, C++, etc., then it may include one or more native modules ... These Java classes and the class files or C-coded native modules of the service are packaged into a JAR file. ..." in par. 0116, lines 1-17)

- installing the OSGi bundle within an OSGi environment of a client device after the packaging ("Installing A Service Bundle" in par. 0137, line 1 and "... a service bundle including a new embedded service, is available within a SMS ... the SMS instructs Active Framework resident on the SMS ... to install a network service on the network device." in par. 0139, lines 1-8)

- deploying the OSGi bundle directly within a native environment of the client device, the native environment being an environment of a primary operating system of the client device and separate from the OSGi environment ("... service is packaged in a "bundle" ... so that it can be deployed in the hosting environment ..." in par. 0041, lines 1-4 and par. 0043, lines 1-8; and see Fig. 1; hosting environment is where the client device uses the services of the Active Framework, where Active Framework lies on top of the operating system. Thus, hosting environment is analogous to native environment; and hosting environment being an environment of a primary operating system of the client device.)

- and controlling the native application within the native environment using the OSGi bundle within the OSGi environment (“... service life-cycle events, e.g. when a service is installed by Active Framework, when a service is upgraded by Active Framework, before a service is uninstalled by Active Framework, when a service is started by Active Framework, before a service is stopped by Active Framework ...” in par. 0049, lines 1-11).

Per Claim 2:

The Bansal publication discloses:

- wherein the controlling step comprises managing a life cycle of the native application (par. 0049, lines 6-11).

Per Claim 3:

The Bansal publication discloses:

- wherein the managing step comprises performing an action selected from the group consisting of starting the native application, stopping the native application, installing the native application and uninstalling the native application (par. 0049, lines 6-11).

Per Claim 4:

The Bansal publication discloses:

- wherein the managing step comprises: issuing a life cycle command from a management program loaded on a server; receiving the life cycle command in the OSGi bundle on the client device; and executing the life cycle command on the native application through an agent on the client device (par. 0139, lines 1-8).

Per Claim 5:

The Bansal publication discloses:

- wherein the agent is a WIN-32 agent within the OSGi environment and wherein the native application is a WIN-32 application (par. 0040, lines 1-10 and par. 0139, lines 1-8).

Per Claim 6:

The Bansal publication discloses:

- wherein the native application is packaged within the OSGi bundle on a server, and wherein the installing step comprises exporting the OSGi bundle from the server to the client device (par. 0047, lines 1-12).

Per Claim 7:

The Bansal publication discloses:

- further comprising removing the native application from within the OSGi bundle while maintaining the link, after the deploying step (par. 0144, lines 1-6).

Per Claim 8:

The Bansal publication discloses:

- packaging a native application within an OSGi bundle on a server to create a link between the OSGi bundle and the native application (“... The Active Framework system and method of the present inventions hosts services that are packaged as bundles, which are containers ... that includes executable as well as non-executables resources for a service. An exemplary bundle comprises Java class files, native library files ...” in par. 0041, lines 1-17; and “... there is illustrated an exemplary embodiment of a bundle packaging. A bundle may contain many types of files. If the service packaged inside the bundle was originally developed in a programming language, e.g., C, C++, etc., then it may include one or more native modules ... These Java classes and the class files or C-coded native modules of the service are packaged into a JAR file. ...” in par. 0116, lines 1-17; and see par. 0047, lines 1-12)

- installing the OSGi bundle within an OSGi environment of a client device after the packaging (“Installing A Service Bundle” in par. 0137, line 1 and “... a service bundle including a new embedded service, is available within a SMS ... the SMS instructs Active Framework resident on the SMS ... to install a network service on the network device.” in par. 0139, lines 1-8)

- **deploying the OSGi bundle directly within a native environment of the client device, the native environment being an environment of a primary operating system of the client device and separate from the OSGi environment** (“... service is packaged in a “bundle” ... so that it can be deployed in the hosting environment ...” in par. 0041, lines 1-4 and par. 0043, lines 1-8; and see Fig. 1; hosting environment is where the client device uses the services of the Active Framework, where Active Framework lies on top of the operating system. Thus, hosting environment is analogous to native environment; and hosting environment being an environment of a primary operating system of the client device.)

- **removing the native application from within the OSGi bundle while maintaining the link** (“... uninstalled ...” in par. 0144, lines 1-6)

- **and managing a life cycle of the native application within the native environment using the OSGi bundle within the OSGi environment** (“... service life-cycle events, e.g. when a service is installed by Active Framework, when a service is upgraded by Active Framework, before a service is uninstalled by Active Framework, when a service is started by Active Framework, before a service is stopped by Active Framework ...” in par. 0049, lines 1-11).

Per Claim 9:

The Bansal publication discloses:

- wherein the managing step comprises: issuing a life cycle command from a management program loaded on the server; receiving the life cycle command in the OSGi bundle; and executing the life cycle command to manage the life cycle of the native application (par. 0139, lines 1-8).

Per Claim 10:

The Bansal publication discloses:

- wherein the executing step comprises the OSGi bundle instructing an agent to manage the life cycle of the native application based on the life cycle command (par. 0139, lines 1-8).

Per Claim 11:

The Bansal publication discloses:

- wherein the agent is a WIN-32 agent within the OSGi environment (par. 0040, lines 1-10).

Per Claim 12:

This is another version of the claimed method discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Bansal.

Per Claim 13:

This is a system version of the claimed method discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Bansal.

Per Claim 14:

The Bansal publication discloses:

- wherein the system for controlling native applications is embodied within a management program loaded on a server (par. 0139, lines 1-8).

Per Claim 15:

The Bansal publication discloses:

- wherein the control system for controlling issues a life cycle command to manage a life cycle of the native application, wherein the life cycle command is received by the OSGi bundle on the client device, and wherein the OSGi bundle instructs an agent within the OSGi environment to carry out the life cycle command (par. 0139, lines 1-8).

Per Claim 16:

This is a system version of the claimed method discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Bansal.

Per Claim 17:

The Bansal publication discloses:

- further comprising a deployment system for deploying the OSGi bundle within the native environment (par. 0041, lines 1-4).

Per Claim 18:

The Bansal publication discloses:

- wherein the deployment system is loaded on a server (par. 0139, lines 1-8).

Per Claim 19:

The Bansal publication discloses:

- wherein the deployment system is loaded on the client device (par. 0041, lines 1-4).

Per Claim 20:

The Bansal publication discloses:

- further comprising a removal system for removing the native application from the OSGi bundle after deployment within the native environment (par. 0144, lines 1-6).

Per Claim 21:

The Bansal publication discloses:

- wherein the removal system is loaded on a server (par. 0139, lines 1-8).

Per Claim 22:

The Bansal publication discloses:

- wherein the removal system is loaded on the client device (par. 0041, lines 1-4).

Per Claim 23:

This is a system version of the claimed method discussed above, claim 8, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Bansal.

Per Claim 24:

The Bansal publication discloses:

- wherein the system for controlling native applications is embodied within a management program loaded on a server (par. 0139, lines 1-8).

Per Claim 25:

The Bansal publication discloses:

- wherein the means for managing issues a life cycle command to manage a life cycle of the native application, wherein the life cycle command is received by the OSGi bundle on the client device, and wherein the OSGi bundle instructs an agent within the OSGi environment to carry out the life cycle command (par. 0139, lines 1-8).

Per Claim 26:

This is a system version of the claimed method discussed above, claim 12, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Bansal.

Per Claim 27:

This is a program product version of the claimed method discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Bansal.

Per Claim 28:

The Bansal publication discloses:

- wherein the program product is embodied within a management program loaded on a server (par. 0139, lines 1-8).

Per Claim 29:

The Bansal publication discloses:

- wherein the program code for controlling issues a life cycle command to manage a life cycle of the native application, wherein the life cycle command is received by the OSGi bundle on the client device, and wherein the OSGi bundle instructs an agent within the OSGi environment to carry out the life cycle command (par. 0139, lines 1-8).

Per Claim 30:

This is a program product version of the claimed method discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by Bansal.

Per Claim 31:

The Bansal publication discloses:

- further comprising program code for deploying the OSGi bundle within the native environment (par. 0041, lines 1-4).

Per Claim 32:

The Bansal publication discloses:

- wherein the program code for deploying is loaded on a server (par. 0139, lines 1-8).

Per Claim 33:

The Bansal publication discloses:

- wherein the program code for deploying is loaded on the client device (par. 0041, lines 1-4).

Per Claim 34:

The Bansal publication discloses:

- further comprising program code for removing the native application from within OSGi bundle after the OSGi bundle is deployed within the native environment (par. 0144, lines 1-6).

Per Claim 35:

The Bansal publication discloses:

- wherein the program code for removing is loaded on a server (par. 0139, lines 1-8).

Per Claim 36:

The Bansal publication discloses:

- wherein the program code for removing is loaded on the client device (par. 0041, lines 1-4).

Response to Arguments

17. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

In the remarks, the applicant argues that:

a) Applicant asserts that claims 1, 8, 13, 23 and 27 reciting “the native environment being an environment of a primary operating system of the client device”, is not new matter.

Particularly, applicant points out paragraphs 0003 and 0020, stating that “the native application may ‘include word processing programs, spreadsheets, etc.,’ all of which may run on a primary operating system. Further, in both paragraph 0003 and 0020, Applicant supports the native environment being an environment of a primary operating system further by stating that the environment may be WIN-32, an environment of the Windows Operating System. It is stated specifically in paragraph 0020 that ‘the OSGi bundle 16 will be deployed in native environment 24 (e.g., a WIN-32 environment) and then native application 18 will be removed.’ It is understood in the art that a native environment may imply that of the operating system, and this is further supported by Applicant's specification.”

Examiner's response:

a) Applicant merely pointed out that “the OSGi bundle 16 will be deployed in native environment” and not “the native environment being *an environment of a primary operating system* of the client device” (emphasis added). Therefore, there is no support for this limitation, thus, this is new matter.

In the remarks, the applicant argues that:

b) Applicant is unclear as to how to claim without using the trademark terms.

Examiner's response:

b) The Examiner suggests that applicant amends the claim to recite the generic description of the trademark terms, such as, “bundles” for the trademark “OSGi”.

In the remarks, the applicant argues that:

c) Bansal fails to teach deploying the OSGi bundle directly within a native environment of the client device, the native environment being an environment of a primary operating system of the client device and separate from the OSGi environment.

Examiner's response:

c) Bansal teaches deploying the OSGi bundle directly within a native environment of the client device, the native environment being an environment of a primary operating system of the client device and separate from the OSGi environment (“... service is packaged in a “bundle” ...

so that it can be deployed in the hosting environment ...” in par. 0041, lines 1-4 and par. 0043, lines 1-8; and see Fig. 1; hosting environment is where the client device uses the services of the Active Framework, where Active Framework lies on top of the operating system. Thus, hosting environment is analogous to native environment; and hosting environment being an environment of a primary operating system of the client device. The Examiner disagrees with Applicant’s assertion that the hosting environment is a non-natural environment.).

Conclusion

18. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Wei Y Zhen, can be reached on (571) 272-3708. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2191

/Qamrun Nahar/

Qamrun Nahar

Primary Examiner, Art Unit 2191

June 22, 2009